

Remarks:

In the January 21, 2003 Office Action, Claims 1-30 were rejected under 35 U.S.C. Section 103(a) as being obvious under Lamm in view of Kolling et al. Accordingly, Claims 1-30 are pending in the application. The reconsideration of the application is respectfully requested.

Electronic bill presentment and payment (EBPP) has evolved swiftly in the past several years; however, EBPP has not gained widespread acceptance for several reasons. One reason is that most consumers are accustomed to receiving bills in hard copy form and paying the bills by check; another reason is that billers are unwilling to commit to electronic billing due to the lack of a universal standard. Thus, the present invention provides a comprehensive bill presentment and bill payment system that receives bills from billers electronically and in hard copy form through the postal service and aggregates the bills of the consumer regardless of the implementation standards of individual billers. In other words, the present invention is not dependent on the evolution of competing electronic bill transmission standard. The present invention presents bills received electronically or bills received in hard copy via the postal service scanning and extracting billing information from paper bills.

Lamm provides a purely electronic EBPP system in which electronic bill files are redacted and reconstructed for presentment to the customer by selecting certain information from the electronic bill and adapting (e.g., inserting standard bill components) the billing information for presentment to the customer. In short, Lamm

provides a method for preparing electronic bills for delivery by removing, deleting, or editing the billing information from electronic bill files. Moreover, Lamm clearly teaches away from the paper billing process, stating that there is a need for a system that "should replace the use of existing paper bills and check to reduce the printing, processing, and postage costs of paper billing" (Lamm, column 3, lines 62-64). It is an objective of Lamm to provide an electronic bill presentment and payment system to eliminate the costs associated with paper billing (see Lamm, Background of Invention).

In the Office Action, the Examiner stipulated that "Lamm does not teach a means for scanning at least one paper bill." See page 2, lines 15-16, January 21, 2003, Office Action. The Examiner cited column 10, lines 7-21 of Kolling et al. to cure this deficiency of Lamm. The Examiner is entirely correct in that Lamm does not teach the steps of scanning and extracting but Applicants, however, cannot agree that Kolling et al. cure this deficiency of Lamm. Kolling et al., like Lamm, is also a purely electronic EBPP system and, like Lamm, teaches away from the paper billing process of the present invention.

Kolling et al. discloses an electronic statement presentment (ESP) system to replace the preparation and mailing of paper statements. Contrary to the Examiner's suggestion that Kolling et al. teach scanning paper bill received for a customer to generate information to present billing information extracted from a paper bill, Kolling et al. use Adobe Acrobat as an authoring tool to create a universal electronic bill statement template by preserving the original document for electronic delivery to replace the

preparation and mailing of paper statements. The use of the "scan/capture" function in Kolling et al. is directed toward the creation of templates to accept electronic bill files from billers with electronic delivery capabilities.

The system disclosed by Kolling et al. works exclusively with billers that have electronic delivery capabilities and, using statement data received electronically from a biller and a "stored" template, creates an electronic statement having the "look and feel" of a paper statement. Kolling et al. provide an electronic bill presentment and payment system to replace the printing, stuffing, and mailing of paper statements with electronic delivery. Thus, in the same manner as Lamm, Kolling et al. teach away from the paper billing process.

Succinctly, the systems disclosed by Lamm and Kolling et al. are no different than other EBPP solutions in that they both require billers to send them billing information in electronic form. Lamm and Kolling et al. teach away from the paper billing process and disclose purely electronic EBPP systems that do not interact with paper bills. In contrast, the present invention distinguishes itself from Lamm and Kolling et al., by embracing the individual billing process of billers, whether it be paper statement delivery or electronic bill delivery. The present invention accepts bills in electronic form from billers that have electronic delivery capabilities and paper bills from billers that do not have electronic delivery capabilities.

Claim 1 distinguishes over Lamm and Kolling et al. by reciting a method of electronically presenting bills by receiving at least one electronic bill for a customer;

scanning paper bills received for a customer to generate electronic image information including billing information; extracting billing information from the electronic image information; and presenting electronic bills and the extracted billing information representative of the paper bills to the customer.

Moreover, it is submitted that Claim 1 is not obvious in view of Lamm and Kolling et al. The Examiner concedes that Lamm does not disclose the scanning step. Applicants further assert that Lamm does not disclose the "extracting" step and the step of presenting both electronic bills and billing information extracted from paper bills. Lamm, like any other EBPP solution, only provides presentment of electronic bills and does not integrate a consumer's paper bills with their electronic bills. For the sake of clarity, Lamm merely redacts electronic bill files by separating sensitive and non-sensitive billing information. Therefore, Lamm would have no reason to consider scanning paper bills and extracting billing information from paper bills.

Similarly, Kolling et al. disclose a purely electronic EBBP system that does not accept paper bills. Kolling et al.'s objective is to eliminate the paper billing process and provides a template tool for converting electronic bill files into a PDF format using Adobe. Although Kolling et al. disclose that Adobe has a scanning feature, Kolling et al. use scanning only to create templates for receiving electronic bills. Kolling et al. do not disclose extracting billing information from electronic image information. Furthermore, Kolling et al. do not present extracted information, representative of a paper bill, along

with an electronic bill to the customer. Kolling et al. presents only bills using billing data received electronically from a biller.

Thus, Lamm and Kolling et al., taken alone or in combination, do not disclose or suggest the steps of Claim 1 for the reasons given above.

As stated above, the Examiner concedes that Lamm doesn't disclose scanning, necessary to allow processing of paper bills in a bill presentment system. Furthermore, Lamm teaches away from paper billing and wants to replace the use of existing paper bills and check to reduce the printing, processing, and postage costs of paper billing.

Similarly, Kolling et al. also teach away from the present invention. For example, Kolling et al., in the first sentence of the Abstract, state that they provide a "system [which] replaces the preparation and mailing of paper statements and invoices from biller with electronic delivery" (Kolling et al., Abstract). See also Kolling et al., column 4, lines 16-18 ("The present invention replaces the printing, stuffing, and mailing of paper statements with the power and efficiency of electronic delivery."). As can be seen, Kolling et al.'s objectives are to eliminate the paper billing system and to work solely with billers with electronic delivery. For instance, the electronic delivery system of Kolling et al. provides electronic authoring tools to create electronic statements with the same "look and feel" as paper statement to reduce the costs associated with preparation and mailing of paper statement (Kolling et al., column 4, lines 52-55). Kolling et al. completely abolish paper bills from the EBPP process. In fact, Kolling et al. assert that the features provided by Kolling et al. "are not possible in the traditional paper-based

process that uses either the post office or a courier to deliver paper statements" (Kolling et al., column 4, lines 47-49).

Teaching away is the antithesis of the art's suggestion that one of ordinary skill in the art move in the claimed direction. Teaching away from the art is a *per se* demonstration of lack of *prima facie* obviousness. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Furthermore, MPEP Section 2144.05 affirms that "[a] prima facie case of obviousness ... [is] rebutted by showing that the art, in any material respect, teaches away from the claimed invention."

Based on the foregoing, it is submitted that Lamm and Kolling et al. do not provide a basis for combining the teachings of the references. Therefore, Applicants respectfully submit that the 103(a) rejection of Claim 1 should be withdrawn.

In view of the distinctions noted and the advantages attendant thereto, it is respectfully submitted that neither Lamm nor Kolling et al., whether taken singly or combined, teach or suggest each and every limitation of independent Claim 1. It is submitted that Claim 1 clearly distinguishes over Lamm and Kolling et al. and is believed to be patentable thereover. Therefore, Applicants respectfully assert that the rejection of Claim 1 under 35 U.S.C. §103(a) should be withdrawn.

Claims 2-8 are dependent upon Claim 1 and are believed to be patentable with the parent Claim 1.

Claim 9, recites the steps of scanning a paper bill, automatically extracting information from the bill, and presenting the extracted information to a customer in a manner similar to Claim 1, and thus, distinguishes over Lamm and Kolling et al. for the same reasons given above. As stated above, Lamm discloses a purely electronic EBPP system. Kolling et al., cited for disclosing means for scanning, is an electronic presentment system that receives electronic billing data from a biller, as described above.

Claim 9, however, is directed toward a method of scanning paper bills, extracting billing information from the scanned paper bills, and presenting the extracted billing information. The invention of Claim 9 closely interacts with a paper billing process and facilitates the presentation of paper bills in electronic formats. As discussed above, neither Lamm nor Kolling et al. interacts with a paper billing process. Although Kolling et al. refer to scanning, Kolling et al. neither disclose nor suggest extracting billing information from scanned paper bills and do not present extracted billing information.

In fact, Kolling et al. do the opposite of the present invention. Namely, Kolling et al. insert electronic billing information into an electronic template to produce an electronic bill that looks like a paper bill. Kolling et al. advocate the use of electronic delivery and provide electronic templates for facilitating electronic presentation of electronic statement data received from billers with electronic delivery. Kolling et al. use Adobe PDF to convert incoming electronic bills to PDF producing exact replicas of the incoming electronic bills for presentment on any computer platforms.

Furthermore, as discussed earlier, both Lamm and Kolling et al. teach way from the paper billing process. Thus, there would be no motivation to combine the cited references to obtain the claimed invention of Claim 9.

In view of the distinctions noted and the advantages attendant thereto, it is respectfully submitted that neither Lamm nor Kolling et al., whether taken singly or combined, teach or suggest each and every limitation of independent Claim 9. It is submitted that Claim 9 clearly distinguishes over Lamm and Kolling et al. and is believed to be patentable thereover. Therefore, Applicants respectfully assert that the rejection of Claim 9 under 35 U.S.C. §103(a) should be withdrawn.

Claims 10-12 are dependent upon Claim 9 and are believed to be patentable with the parent Claim 9.

Claim 13, recites the steps of scanning and extracting in a manner similar to Claim 1, and further distinguishes over Lamm by reciting storing a scanned image of a remittance stub for the paper bills and printing the stored scanned image of the remittance stub for the paper bill. As can be seen, Claim 13 stores the original remittance stub from the paper bill and allows the printing of a copy of the original remittance stub from the paper bill. With this feature, the customer can choose to use online payment options or print the remittance stub to manually pay the biller through the postal service.

As discussed above, Lamm does not disclose the steps of scanning or extracting. Furthermore, Lamm does not disclose the step of storing the remittance stub and printing

the remittance stub. Lamm is simply an electronic system incapable of interacting with a paper billing process.

Kolling et al. provide Adobe PDF software to convert electronic bills into PDF for viewing. Kolling et al. do not scan paper bills. Moreover, Kolling et al. do not extract billing information, and Kolling et al. do not interact with a paper billing process. In addition, Kolling et al. do not store the original remittance stub from the paper bill, and do not print the original remittance stub from the paper bill.

Thus, neither Lamm nor Kolling et al. disclose each and every feature of Claim 13, and Kolling et al. do not suggest modification of Lamm that would anticipate Claim 13. In fact, Kolling et al. purposefully designed an EBPP system to replace the paper billing process. Moreover, Kolling et al. teach away from storing and printing of a remittance stub. As disclosed by Kolling et al., "problems result when consumers do not pay the entire amount due on the payment stub, the payment stub becomes not computer-readable, or the consumer does not mail the payment stub with the payment" (Kolling et al., column 1, lines 64-67). In addition, Kolling et al. states that the remittance stub process "requires large amounts of time and money to process paper bills, checks, and stubs" (Kolling et al., column 2, lines 1-3). Thus, Kolling et al. effectively teach away from the use of a remittance stub as claimed.

In view of the distinctions noted and the advantages attendant thereto, it is respectfully submitted that neither Lamm nor Kolling et al., whether taken singly or combined, teach or suggest each and every limitation of independent Claim 13. It is

submitted that Claim 13 clearly distinguishes over Lamm and Kolling et al. and is believed to be patentable thereover. Therefore, Applicants respectfully assert that the rejection of Claim 13 under 35 U.S.C. §103(a) should be withdrawn.

Claims 14-15 are dependent upon Claim 13 and are believed to be patentable with the parent Claim 13.

Independent system Claims 16, 24 and 28 are written in a fashion similar to independent method Claims 1, 9, and 13, respectively. All arguments presented herein for Claims 1, 9 and 13 apply equally to Claims 16, 24 and 28, respectively. Therefore, in view of the distinctions and advantages as noted above with respect to Claims 1, 9, and 13, it is respectfully submitted that neither Lamm nor Kolling et al., whether taken singly or combined, teach or suggest each and every limitation of independent Claims 16, 24, and 28. It is submitted that Claims 16, 24 and 28 clearly distinguish over Lamm and Kolling et al. and are believed to be patentable thereover. Therefore, Applicants respectfully assert that the rejection of Claims 16, 24 and 28 under 35 U.S.C. §103(a) should be withdrawn.

Claims 17-23 are dependent upon Claim 16 and are believed to be patentable with the parent Claim 16.

Claims 25-27 are dependent upon Claim 24 and are believed to be patentable with the parent Claim 24.

Claims 29-30 are dependent upon Claim 28 and are believed to be patentable with the parent Claim 28.

In summary, Claims 1-30 are believed to be allowable for the reasons given herein. Accordingly, these claims remain pending following entry of this Amendment, and are believed to be in condition for allowance at this time. As such, Applicants respectfully request entry of the present Amendment and reconsideration of the application, with an early and favorable decision being solicited. Should the Examiner believe that the prosecution of the application could be expedited, the Examiner is requested to call Applicants' undersigned representative at the number listed below.

Respectfully submitted,
REINHART BOERNER VAN DEUREN s.c.

By: Leonard J. Kalinowski
Leonard J. Kalinowski
Reg. No. 24,207

Customer No. 22922
REINHART BOERNER VAN DEUREN s.c.
1000 North Water Street
Suite 2100
Milwaukee, WI 53202
414-298-8359